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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,392	07/26/2001	Mark R. Newsome	10005624-1	7780

7590 05/02/2005

HEWLETT-PACKARD COMPANY
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EXAMINER

QUELER, ADAM M

ART UNIT PAPER NUMBER

2179

DATE MAILED: 05/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,392

Applicant(s)

NEWSOME, MARK R.

Examiner

Adam M Queler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Amendment filed 01/19/2005.
2. Claims 1-25 are pending in the case. Claims 1, 4, 10, 15, 17, 18, 22, and 24 are independent claims.
3. The rejections of claims 4-9 under 35 USC § 102 are withdrawn in view of Applicant's amendment.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-3, 10-14, 17, 22-23 remain rejected under 35 U.S.C. 102(e) as being anticipated by Mankoff (US006385591B1, filed 5/11/1999).**

Regarding independent claim(s) 1, 17, Mankoff discloses a user selecting one of the images (col. 4, ll. 8-9) and storing the image (col. 4, ll. 14-15). Mankoff teaches storing the URL (col. 1, ll. 55-58). Mankoff also teaches that coupons can be on the business's web site (col. 5, ll. 48-52). In this case the contact info is the network address.

Regarding independent claim(s) 10, 18, and 22, Mankoff discloses displaying a web site with a clickable image (col. 1, ll. 44-50). Inherent, in displaying a web site, the page must be parsed and an indication must be made of items, such as links, which are clickable. Mankoff discloses a user selecting one of the images (col. 4, ll. 8-9) and storing the image (col. 4, ll. 14-15).

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Regarding dependent claim(s) 11, 23, Mankoff teaches storing the URL (col. 1, ll. 55-58).

Mankoff also teaches that coupons can be on the business's web site (col. 5, ll. 48-52). In this case the contact info is the network address.

Regarding dependent claim(s) 2, 13, Mankoff teaches the coupon in its entirety, which includes the image, is stored in a file (col. 1, ll. 54-55).

Regarding dependent claim(s) 12, Mankoff teaches the coupon in its entirety, which includes the image, is stored in a file (col. 1, ll. 54-55). Mankoff teaches storing the URL (col. 1, ll. 55-58). Mankoff also teaches that coupons can be on the business's web site (col. 5, ll. 48-52). In this case the contact info is the network address.

Regarding dependent claim(s) 3, 14, and 20 Mankoff teaches storing in a user selected location (col. 4, ll. 42-45).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 15-16 and 24-25 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Mankoff, and further in view of Nilsson (US006085110A, filed 121/1997).**

Regarding independent claim(s) 15, 24, Mankoff discloses displaying a web site with a clickable image (col. 1, ll. 44-50). Inherent, in displaying a web site, the web page and therefore the content within must be selected prior to loading, and the page must be parsed and an indication must be made of items, such as links, which are clickable. Mankoff discloses a user

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selecting one of the images (col. 4, ll. 8-9) and storing the image (col. 4, ll. 14-15). Mankoff does not teach automatic selection when there is only one image. Nilsson teaches choosing something when it is the only choice (col. 9, ll. 62-65). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Nilsson and Mankoff thereby storing if only one image is found, because it would save time when there is only possible choice.

Regarding dependent claim(s) 16 and 25, Mankoff teaches storing the URL (col. 1, ll. 55-58). Mankoff also teaches that coupons can be on the business's web site (col. 5, ll. 48-52). In this case the contact info is the network address.

8. Claims 4-9 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankoff, and further in view of Ramos (US006421070B1-filed 10/1/1998).

Regarding independent claim(s) 4 and 18, Mankoff discloses displaying a web site with a clickable image (col. 1, ll. 44-50). Mankoff discloses a user selecting one of the images (col. 4, ll. 8-9) and storing the image (col. 4, ll. 14-15). Mankoff does not explicitly disclose a new window. Ramos teaches displaying a new window that indicates images (col. 1, ll. 59-63).

Ramos discloses this done through parsing (col. 2, ll. 46-49). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Mankoff and Ramos in order to enable all the images to be saved (col. 3, ll. 30-38).

Regarding dependent claim(s) 5 and 19, Mankoff teaches storing the URL (col. 1, ll. 55-58). Mankoff also teaches that coupons can be on the business's web site (col. 5, ll. 48-52). In this case the contact info is the network address.

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Regarding dependent claim(s) 6, Mankoff teaches the coupon in its entirety, which includes the image, is stored in a file (col. 1, ll. 54-55). Mankoff teaches storing the URL (col. 1, ll. 55-58). Mankoff also teaches that coupons can be on the business's web site (col. 5, ll. 48-52). In this case the contact info is the network address.

Regarding dependent claim(s) 7, Mankoff teaches the coupon in its entirety, which includes the image, is stored in a file (col. 1, ll. 54-55).

Regarding dependent claim(s) 8 and 20, Mankoff teaches the storing in a user selected location (col. 4, ll. 42-45).

Regarding dependent claim(s) 9 and 21, Mankoff discloses displaying a web site with a clickable image (col. 1, ll. 44-50). Mankoff discloses a user selecting one of the images (col. 4, ll. 8-9) and storing the image (col. 4, ll. 14-15). Mankoff does not explicitly disclose a new window. Ramos teaches displaying a new window with thumbnails (col. 1, ll. 59-63). Ramos discloses this done through parsing (col. 2, ll. 46-49). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Mankoff and Ramos in order to enable all the images to be saved (col. 3, ll. 30-38).

Response to Arguments

9. Applicant's arguments filed 01/19/2005 have been fully considered but they are not persuasive.

Regarding Applicant's remarks on Claims 1 and 17:

Applicant alleges that Mankoff does not store the file. However, the file on the separate server is still the coupon initially selected (col. 4, ll. 1-4).

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Applicant alleges that Mankoff does not store the network address, but rather an address about the coupon provider. However, Mankoff also teaches that coupons can be on the business's web site (col. 5, ll. 48-52). In this case the contact info is the network address.

Regarding Applicant's remarks on claims 10 and 22:

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a limited indication of clickable images) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding Applicant's remarks on claims 15 and 24:

Applicant alleges that Mankoff does not teach parsing selected content for clickable images. However, the web page and therefore the content within must be inherently selected prior to loading.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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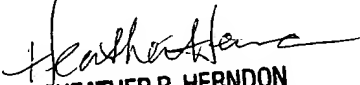
CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M Queler whose telephone number is (571) 272-4140. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AQ


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